REMARKS

By this submission accompanying with a request for continued examination, claims 1, 2, 4-6, 8-12 are amended. Accordingly, claims 1-12 are pending in this application and claims 1-12 are respectfully submitted for a timely examination.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 10 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 10 has been amended responsive to this rejection. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

In addition, claims 1, 2, 4, 11 and 12 have been amended to correct a minor spelling error to place the claims in better compliance with U.S. patent practice. It is submitted the mere spelling correction does not further narrow the scope of the claims.

Rejection of Claims 1-12 Under 35 U.S.C. § 103(a)

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,236,955 to Summers (herinafter, "Summers") in view of U.S. Patent No. 6,330,545 to Suh (hereinafter, "Suh"). It is noted that claim 10 has been amended. To the extent that the rejection remains applicable to the claims currently pending, the Applicants hereby traverse the rejection, as follows.

In making this rejection, the Examiner took the position that Summers discloses all of the limitations of claims 1-12, with the exception of each set of evaluation values having a plurality of values on a plurality of evaluation factor axes in the business unit analysis.

The Applicants respectfully disagree and submit that independent claims 1, 11 and 12, recite at least the following additional subject matter that is neither anticipated nor rendered obvious by Summers.

Claim 1 recites, in part:

> a storage device for storing a plurality of data sets of evaluation values for every business unit to be analyzed, each data set containing evaluation values respectively representing results of a business unit evaluation as to a plurality of evaluation factors, and having an attribute representing conditions of the evaluation, said attribute defined on each of a plurality of axis representing a factor of evaluation condition at a position indicating a concrete condition concerning the factor, some of the data sets having attributes defined at different position on one axis but positioned at same position on all other axis...

Claim 11 recites, in part:

> extract a data set of evaluation values related to the business unit to be analyzed in accordance with a predetermined extracting condition of a predetermined attribute of the data set of evaluation values, said data set of evaluation values further having different values on a first axis and having the same values on all other axis...

Claim 12 recites, in part:

> a storage device for storing a plurality of data sets of evaluation values for every business unit to be analyzed, each data set containing evaluation values respectively representing results of a business unit evaluation as to a plurality of evaluation factors, and having an attribute representing conditions of the evaluation, having attributes defined at different position on one axis but positioned at same position on all other axis...

In making the rejection, the Examiner asserted, that

> it was old and well known at the time of the invention to allow one variable in a simulation to vary while holding all others constant... The purpose of such a procedure is to allow an analyst to identify the particular variable associated with a change. If more than one variable is allowed to vary, it is impossible to identify the effect of each variable, producing useless analysis. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform this variable "fixing" *of Summers* to allow attribution of effect to an identifiable variable. *Office Action*, p. 8.

The Applicants respectfully traverse and submit that it would **NOT** have been obvious to one of ordinary skill in the art at the time of the invention to "perform this variable 'fixing' *of Summers* to allow attribution of effect to an identifiable variable," as suggested by the Examiner, at least because Summers explicitly teaches away from such "variable fixing." For example, at col. 12, lines 12-41, Summers discloses:

> an optimal product cannot be discovered by varying the attribute-characteristics independently...Because of this quality of multipeaked value functions, students cannot find the optimal product by considering each attribute independently. Instead, students must simultaneously consider several attributes. *Summers*, col. 12, lines 12-13 and 38-40.

Thus, Summers clearly teaches that the proposed modification, i.e., "variable fixing" is not desirable.

The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. It is not enough that one may

modify a reference in view of a second reference, but rather it is required that the second reference suggest the modification of the first reference, and not merely provide the capability of modifying the first reference.

The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy its burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). **There is no suggestion to combine, however, if a reference teaches away from its combination with another source** (emphasis added). In re Fine, 837 F.2d 1075, 5 USPQ2nd 1599 (Fed. Cir. 1988). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

The Applicants further submit that the intent of Summers is to "simultaneously consider several attributes" in order to find the "optimal product," which, according to Summers, "cannot be discovered by varying the attribute-characteristics independently." Summers, col. 12, lines 12-13 and 38-40.

Thus, the Applicants submit that it would not have been obvious to one of ordinary skill in the art at the time of the invention to perform "variable fixing" in Summers "to allow attribution of effect to an identifiable variable," as suggested by the Examiner in the outstanding Office Action. Moreover, the Applicants submit that the rejection of claims 1, 11 and 12, as being unpatentable over Summers in view of the Examiner's statement is improper, and withdrawal of the rejection is requested.

In addition, in the outstanding Office Action, the Examiner asserts that Summers discloses at col. 2, lines 21-41, and col. 19, lines 3-13, "[a] storage device for storing a plurality of sets of evaluation values for every business unit to be analyzed, each set of the evaluation values contains the results of a business unit evaluation in accordance with a plurality of evaluation factors" and "said set of evaluation values further having different values on a first evaluation factor axis and having the same values on all other evaluation factor axes" as in the claimed invention.

However, col. 2, lines 30-40 of Summers merely discloses "[t]he display gathers information from the simulated business situations and displays this information for the students. After witnessing the information, the students make decisions. The students enter their decisions into the business situation via an input device. Upon receiving the students' decisions, the business simulation manipulator calculates the effects of the

students' decisions in the simulated business situation. Information from the affected business situation is then displayed for the students." Therefore, the Applicants submit that the information gathered by the display is not based on the results of a business unit evaluation in accordance with a plurality of evaluation factors, as are the evaluation values of the claims.

Furthermore, in the outstanding Office Action, the Examiner admits that Summers fails to disclose "said set of evaluation values having a plurality of values on a plurality of evaluation factor axes." Suh is cited as allegedly curing this deficiency of Summers. However, in making the rejection, the Examiner fails to satisfy his burden of establishing a prima facie case of obviousness. In the Office Action, the Examiner merely states that the motivation for combining the references is found in certain advantages stated by the Examiner (see, e.g., Office Action, page 3, last paragraph). The Examiner indicates nothing from within the applied references to evidence the desirability of this combination. This is an insufficient showing of motivation.

For all of these reasons, the Applicants submit that claims 1, 11 and 12 are allowable over the combination of cited prior art references. As claim 1 is allowable, the Applicants submit that claims 2-10, which depend from allowable claim 1, are likewise allowable over the cited prior art.

Conclusion

In view of the above, Applicants respectfully submit that each of claims 1-12 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicants also submit that the subject matter is more than sufficient to render the

claims non-obvious to a person of ordinary skill in the art, and therefore respectfully request that claims 1-12 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referring to client-matter number 024201-00001.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (three months minus one month)